REMARKS

In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. This amendment is believed to be fully responsive to all issues raised in the 08/08/2005 Office Action.

Claims Amendments

Claims 1—15, 31—45 and 61—75 are original and 91—109 were previously presented.

The §103 Rejections

The Applicant submits that the Office has failed to establish a *prima facie* case of obviousness and, in view of the comments below, respectfully traverses the Office's rejections.

The §103 Standard

To establish a *prima facie* case of obviousness, three basic criteria *must* be met. MPEP § 2142. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Hence, when patentability turns on the question of obviousness, the search for, and analysis of, the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine or

modify the references relied on as evidence of obviousness. The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

The Kim Reference

The Kim Reference teaches a browser adapted to put advertisements onto the screen. In particular, Kim teaches an application which runs as part of, or in conjunction with, a browser program. The application periodically downloads advertisements (ads) when the browser is substantially idle and stores them locally (Abstract; lines 4—7). Kim detects transition from a first web page to a second web page, and takes advantage of the time during which it takes the second webpage to download ([0045]; lines 1—2) to display ([0077]; lines 5—10) the locally stored ads. Note that the ad may occupy the full window of the browser ([0078]; lines 2—5), a partial window, or may be positioned outside the window ([0078]; lines 10—13).

Therefore, Kim teaches browser technology configured *for the display of ads*, either in the full browser window, a part of the browser window or in a new window. The ads are displayed in response to a change from the first webpage to the second webpage. However—as the Office Action points out and the Applicant agrees—Kim does not disclose ignoring requests for a second window where the request was not initiated in response to user action.

Kim mentions pop-up ads in four paragraphs. In [0009], Kim mentions that pop-up ads may result in "consumers (becoming) upset and bothered." The context for this statement is that pop-up ads are not a beneficial method for

advertising and that advertisers should advertise according to the methods of Kim. The context of this statement is *not* that Kim is considering ways to fight pop-up ads. Kim is only saying that Kim's way of advertising is a better way of advertising. In [0038], Kim again indicates that pop-up ads are not an effective advertising tool. In [0123] Kim mentions that pop-up ads can block the user's view, and in [0145], Kim mentions the interference pop-up ads can cause. However, nothing in Kim suggests that Kim is considering "fighting" pop-up ads; only that Kim considers them an inferior method of advertising. Kim is in fact very pro-advertising, having disclosed a system and method for advertising. Accordingly, nothing in Kim suggests that Kim is considering the addition of an apparatus or method of stopping pop-up ads.

The "How-To" Reference

In contrast to the browser software seen in Kim, the How-To reference teaches *changing the code that comprises a website* to prevent the host of the website from inserting successful pop-up ads into responses sent by the website to hits made on the website.

In particular, the How-To reference discloses a number of strategies by which a website owner can change a website to prevent display of advertisements that the host server of the website inserts. Accordingly, the How-To reference does not disclose browser technology that ignores or follows instructions for opening a second window. Instead, How-To discloses website modifications.

In general, the background and teachings of How-To may be understood by the following exemplary scenario:

1. A Website Admin writes code to configure a Website.

2. The Website Admin hires Host (an internet service provider (ISP)) to physically host the Website.

3. Website Admin notices that Host is injecting Host's pop-up ads into the responses to "hits" on Admin's website. Website Admin is upset, since Website viewers may avoid Website due to Host's advertising.

4. Website Admin investigates and realizes that Host is employing any of several methods to introduce the ads. Accordingly, Website Admin must find out (1) what the Host is doing to introduce the pop-up ads, and (2) consult How-To for indicated remedy. For example to kill pop-up as they appear, Admin must check to see what Host has named the window (How-To, middle of page 3 of 6).

5. Website Admin alters the code in Website (according to How-To's instructions) to nullify Host's strategy of introducing pop-up ads into Website Admin's Website.

Thus, How-To is adapted for use on a website to thwart ads injected by the website's host. How-To instructs that the host may employ any of many strategies to insert pop-up ads—accordingly, How-To provides six pages of possible solutions. *None of the solutions always works. The administrator of the website must find the solution that works in view of what the host is doing. The administrator must then change the code of the website.*

While How-To's technology works well for website owners, it does not combine with browser technology in a successful manner.

Traversal of the §103 Rejections

Claims 1—15, 31—45 and 61—75 are 91—109 were rejected under 35 U.S.C. section 103(a) as being anticipated by U.S. application 2002/0052925 ("Kim") and the How-To document (How-To). The Applicant respectfully traverses the rejection of claims 1—15, 31—45 and 61—75 are 91—109.

Claim 1 recites a computer system having a graphical user interface including a display and a user interface selection device, a method of maintaining a single window interface, comprising:

- receiving a request to open a second browser window while a first browser window is displayed;
- **ignoring the request if the request was not initiated in response to a user action**; and
- opening the second browser window if the request was initiated in response to a user action.

Claims 31, 61, and 91 include similar recitations, and the rejection of all four claims will be discusses simultaneously.

The Kim reference was cited as an example of a graphical user interface with a display and a user interface selection device, which has means for receiving a request to open a second browser window while a first browser window is displayed, and opening the second browser window if the request was initiated in response to a user action. However, as the Patent Office stated, "Kim does not disclose ignoring the request if the request was not initiated in response to user action." (OA mailed 02/24/2006, bottom of page 2 and top of page 3.) Accordingly, the Patent Office cited How-To in an attempt to remedy Kim's deficiencies. The Applicant respectfully asserts that How-To does not remedy the deficiencies of Kim.

Even if Kim and How-To are combined, the result does not teach or suggest the recited claim elements. Kim teaches browser technology. The How-To reference teaches methods to modify the code of a webpage operating on a host server to prevent the host server from sending pop-up ads configured to successfully open as windows on user interfaces of client computers visiting the webpage. However, How-To does not teach or suggest any software structures and/or code that are configured for use on a browser or client computer. Thus, the combination of Kim and How-To results in a browser according to Kim and a website according to How-To. In contrast, the claim recites a computer system having a graphical user interface configured to maintain a single window interface.

The Patent Office suggests that How-To discloses ignoring a request to open a second window if the request was not initiated in response to user action, and that combination of the teachings of Kim and How-To result in the claim as recited. The Applicant respectfully disagrees. Instead of teaching "ignoring the request" to open a second window, How-To teaches that the website code can be modified. How-To fails to teach or suggest how How-To's website programming could be modified for combination with Kim's browser technology, and for at least this reason, fails to teach or suggest the elements recited by the claim. Moreover, integration of How-To's website modifications with the browser of Kim appears to present insurmountable technological incompatibilities. Accordingly, the combination of Kim and How-To fails to teach the claim as recited, and is unwarranted.

Changes made to the code at the website location (according to How-To's suggestions) do not teach or suggest features that could be implemented in a computer system having a graphical user interface configured to maintain a single

window interface, as claimed. Thus, How-To is deficient in part because the How-To's programming is configured only for operation within the website on the server, and no teachings or suggestions are made for inclusion of such programming in a browser. Accordingly, the combination of Kim and How-To teach results in a browser, such as that disclosed by Kim, and a modification to a website, such as that disclosed by How-To. In contrast, the Applicant's claim recites a computer system having a user interface configured for single window operation. Thus, the teachings of Kim, combined with the teachings of How-To, fail to teach or suggest a computer system configured to maintain a single window interface.

The Technology of How-To Cannot be Adapted for Use in a Browser

To justify the combination of two references in making a section 103 rejection, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the technologies of Kim and How-To can not be combined. A number of factors prevent application of How-To's technology to browsers.

Technical difficulties, such as unresolved issues regarding application of How-To's website-based technology to a browser, prevent How-To from being combined with Kim or any other browser technology. For example, the references do not disclose how the browser can be configured to choose from among How-To's strategies, when How-To fails to provide an algorithm by which a correct strategy can be immediately selected. How-To fails to disclose how someone without access to a "clean" version of the website code (i.e. website code unpolluted by ads) can know which part of the code downloaded from the website can safely be commented out. How-To fails to disclose how someone without

access to a "clean" version of the website code can know which window names are those of valid website windows, and which window names are those of ads. How-To fails to disclose how someone without access to a "clean" version of the website code can know whether it is safe to apply some of How-To's tricks, such as disabling JavaScript. Therefore, while How-To's technology is well-adapted for the disclosed use, the combination of Kim's technology with How-To's technology has little expectation of success.

How-To provides ten or more strategies for thwarting ads, and assumes that a website owner can figure out which strategy is appropriate for the website in question. How-To is silent about how a browser could block ads. For example, no automated method is disclosed of quickly figuring out what strategy should be applied to any given website. How-To implies that the website owner will have to investigate and do some trial and error work to determine what the host is doing to insert ads, and then select an appropriate fix from How-To's technology. However, Kim does not, and How-To does not, suggest a method by which a browser could know which of How-To's fixes to apply for use with an arbitrary website visited by the browser. Thus, while How-To works fine for the website owner who can patiently figure out which of How-To's fixes to apply, How-To's technology is not adapted for use with a browser, since How-To provides no automated mechanism which explains which fix should be applied by the browser when receiving information from any given website.

Several of How-To's strategies involve "commenting out" parts of the code sent to the browser. That is, statements intended to create ads are turned into ineffective "comments" by the changes made to the code by the How-To teachings. This assumes knowledge of the website's code, and the ability to

distinguish the website's non-advertisement code from advertisement code inserted by the host. The website owner has this knowledge, and is in a position to distinguish the ad-related code. The browser has no way of distinguishing website code from ad code. The website owner is familiar with the website code, and is able to insert the <noscript> or <!—(comment) tags suggested by How-To (How-To, page 1) in the correct locations. However, How-To is silent about how a browser could possibly know where to insert the comment tags. For example, the website may have a "good" window and a pop-up ad window, and the browser (not having the information available to How-To's audience of website owners) would not know which was which. Thus, while a website owner would know which window to comment out, the browser could not possibly know. Thus, while How-To's technology works fine for the website owner, it would not work for a browser.

Several of How-To's fixes involve learning the name of pop-up ad windows, and then using that information to thwart opening of the pop-up ad window. Learning the window name is possible for the website owner, who can experiment some, and learn the name(s) of windows that are not part of the website (and are therefore ads). However, How-To provides no information on how a browser could determine—between two window names within the code sent by the website—which was the pop-up ad window and which window was part of the website. Thus, while the owner of the website would know the name of the website's windows (and thus be able to distinguish the names of the ad windows) the browser could not possibly have this information. Thus, while How-To's technology works fine for the website owner, it would not work for a browser.

Several of How-To's techniques require some knowledge of the website's code in order to know if a given fix can be safely used. For example, according to one of How-To strategies, pop-up ads may be killed by turning off JavaScript. However, this is only applicable where the website itself does not use JavaScript. How-To—whose audience includes website owners—assumes that 'Can JavaScript be turned off without impacting the website?' is an easy question. However, How-To does not make it clear how a browser—that may be downloading code for the first time from a website—could answer such a question. Thus, while How-To's technology works fine for the website owner, it is not adaptable to a computer system configured to maintain a single window interface.

Thus, while How-To teaches how a website owner can block ads, How-To fails to teach or suggest a method by which a computer system can maintain a single window interface. In fact, a number of unresolved technical issues indicate that combination of the How-To reference with Kim should not be expected to result in success. Accordingly, the combination of How-To and Kim is improper.

The Patent Office suggests that since How-To teaches blocking ads that were not requested, that How-To's technology could be combined with the browser of Kim to yield a combined technology disclosing the recited claim. The Applicant respectfully disagrees. As shown above, the combination of How-To and Kim would raise substantial unresolved technical issues, *and would be inoperative*. This is partly the case because How-To discloses formatting data for transmission to a web browser, while Kim discloses operation of a web browser.

For example, one or more of How-To's solutions may be applicable to removing ads from a web administrator's website, wherein the administrator

knows the website's code (in its state unpolluted by ads). However, How-To does not resolve technical issues raised by the need to remove ads from any arbitrary website wherein access to the website's code unpolluted by ads is not known.

Kim and How-To Teach Away from Combination

Kim and How-To teach away from their combination based in part on their teachings with respect to the utility of advertising. Kim is "pro ad" and How-To is "anti ad." An inventor would not think to combine such references. Kim discloses technology adapted display ad for viewing by a browser user. In contrast, How-To discloses technology adapted to package website responses in a way that prevents pop-up ads. Accordingly, it is not foreseeable that an inventor would combine such a "pro ad" reference with such an "anti ad" reference.

Kim and How-To teach away from their combination based in part on their differences in the platform upon which they are configured to operate. Kim is intended as a browser and/or browser enhancement operable on a client. In contrast, How-To is configured for operation on a website, located on a server/host. An inventor would not think to combine such references. *The executable code for the references is not configurable to operate on the same computer.* Accordingly, it is not foreseeable that an inventor would combine a 'client-side browser' reference with a 'server-side website' reference.

Combination of Kim & How-To Represents Use of Hindsight by Office

The combination of Kim and How-To represent impermissible use of hindsight by the Patent Office. In fact, nothing in Kim would suggest combination with How-To. Kim discloses aspects of browser technology. How-To discloses aspects of website software, particularly for use when the host tries to insert ads into responses to 'hits' on the websites pages. Because Kim discloses browser

operations on a client, and because How-To discloses website operations on a server (host), there is no suggestion by either that combination with the other is desirable or would even result in a computer system configured to maintain a single window interface. Moreover, as seen above, since Kim and How-To represent technologies that cannot be combined without resolution of many technical issues, their combination is not foreseeable and would therefore represent hindsight.

Conclusion of Remarks on Claims 1, 31, 61 and 91

For these reasons and others, Kim, adapted with How-To's technology, would be non-functional, and the combination of Kim and How-To is improper. Accordingly, the Applicant respectfully requests that the rejection of claims 1, 31, 61 and 91 be removed.

Claim 9 recites a computer system having a graphical user interface including a display and a user interface selection device, a method of maintaining a single window interface, wherein the method further comprises:

- suppressing a request to open a dialog box until a browser window associated with the request to open the dialog box is displayed.

Claims 39, 69, and 99 include similar recitations.

The Patent Office cites Kim at paragraph 77, lines 8—14. However, the cited portions of the Kim reference fail to disclose the use of a dialog box generally, or suppressing a request to open a dialog box particularly. In contrast, the cited passage discloses showing an ad if the download time exceeds a threshold time. Therefore, the elements recited by the claims are not shown, and

the rejection is improper. Accordingly, the Applicant respectfully requests that the rejection be removed from claims 11, 41, 71 and 101.

Claim 11 recites a computer system having a graphical user interface including a display and a user interface selection device, a method of maintaining a single window interface, wherein the method further comprises:

- receiving a request to close a browser window;
- closing the browser window if another browser window is open; and
- ignoring the request if no other browser window is open.

Claims 41, 71, and 101 include similar recitations.

The Patent Office cites Kim at paragraph 77, lines 16—19. The cited portions of the Kim reference refer to detecting whether a webpage downloading time, which if exceeded, results presentation of an ad. After the ad is displayed for a contracted time, the ad is removed and the downloading page is displayed. This does not disclose, "receiving a request to close a browser window," since no request is disclosed. It also does not disclose, "ignoring the request if no other browser window is open," since no ignoring is disclosed. Accordingly, the rejection is improper, and the Applicant respectfully requests that the rejection be removed from claims 11, 41, 71 and 101.

Claim 12 recites a computer system having a graphical user interface including a display and a user interface selection device, a method of maintaining a single window interface, wherein the method further comprises:

- maintaining, in a browser history, a history of transitions between the first and second browser windows.

Claims 42, 72, and 102 include similar recitations.

The cited portions of the Kim reference refer to archiving *information content* (Kim, paragraph 0049). This is not the same as "maintaining a browser history," *i.e.*, the list that instructs the browser which page to go to when the back and forward browser buttons are pressed. Accordingly, the rejection is improper, and the Applicant respectfully requests that the rejection be removed from claims 12, 42, 72 and 102.

Claim 13 recites a computer system having a graphical user interface including a display and a user interface selection device, a method of maintaining a single window interface, wherein the method further comprises:

- building the browser history from a history of a displayed browser window.

Claims 43, 73, and 103 include similar recitations.

The cited portions of the Kim reference refer to archiving *information content* (Kim, paragraph 0049). This is not the same as "building a browser history from a history of a displayed browser window." Accordingly, the rejection is improper, and the Applicant respectfully requests that the rejection be removed from claims 12, 43, 73 and 103.

Claims 2—15, 32—45, 62—75 and 92—105

These claims are allowable due to their dependency on claims that are allowable for the reasons seen above, as well as for reasons associated with the elements recited in each claim.

Claims 106—109

Claims 106—109 are allowable as being dependent on claims allowable for the reasons seen above, as well as for reasons associated with the elements recited in each claim. In particular, claims 106—109 recite an example of how "in response to user action" and "not in response to user action" can be determined. Neither Kim nor How-To evaluate "if the request" was or was not initiated "in response to a user action." Accordingly, neither Kim nor How-To disclose the elements recited in claims 106—109, which are allowable for at least this reason.

Conclusion

The technology of the How-To is not adapted for combination with the Kim reference. While How-To may disclose technology that is well adapted to modify websites in a manner that thwarts ads, How-To fails to disclose how this technology could be adapted for use in browsers. Therefore, a combination of Kim's technology and How-To's technology would be non-functional, in part due to large and unresolved technical issues. Additionally, combination of Kim and How-To is by way of hindsight, and fails to address technical issues that prevent their combination. And further, Kim and How-To teach away from combination for at least two reasons: Kim is "pro ad," while How-To is "anti ad"; additionally, Kim is client-base, while How-To is server-based. Accordingly, the combination of Kim and How-To is improper. Therefore, the Applicant respectfully requests that the rejection to claims 1—15, 31—45, 61—75 and 91—109 be removed. Should any issue remain that prevents immediate issuance of the application, the Examiner is encouraged to contact the undersigned attorney to discuss the unresolved issue.

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